

Remarks

Thank you for your continued work in connection with this application. A request for continued examination accompanies this Amendment. Following are Applicants' remarks responsive to the September 22, 2006 Office Action.

The claims are amended as noted. Text deletions are indicated by strike out marks or double bracketing and text additions are underlined.

Claims 45, 49, 17, 26 and 28 are the five independent claims pending in the application. Claims 45, 49, 17, 26 and 28 are amended to define Applicants' compositions as being refrigerated compositions dispensable from a pressurized container. The adjective "refrigerated," of course, merely refers to a composition which is made or kept cold or cool. Claims 2-4, 27 and 29 modify aerosol to pressurized container; an aerosol container is a type of pressurized container. Claim 11 is amended to correct dependency.

Support for the claim amendments is found in the application, for example, at 4:9-14, 6:17-19, 7:3-4, 7:28 through 8:2, 9:12-30, 14:20-21, 15:6-16. (reference is to page:lines)
No new matter is added as is apparent from these citations.

Response to Rejections

Independent claims 45, 49, 17, 26 and 28 are believed to be rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,759,609 (Lynch) alone or in combination with U.S. Patent No. 6,372,280 (Gonsalves) or other secondary references. Lynch is the primary reference for all rejections. Reconsideration is requested in view of the accompanying remarks and experimental evidence.

In the Amendment mailed June 22, 2006 Applicants argued that the Office had not presented a *prima facie* case of obviousness based on Lynch alone, or Lynch in combination with Gonsalves, or in combination with the other secondary references. June 22 Amendment at pages 25-29. It was argued that Lynch taught away from Applicants' claims and did not render the claims obvious because Lynch was directed to a low/no fat, low caloric density desert food

product with a maximum theoretical fat content of 7% by weight, with Lynch's examples (Lynch Table 1) actually showing a much lower fat content of 3-4% by weight. June 22 Amendment at pages 25-27.

It was further argued that it is contrary to law to combine Lynch and Gonsalves because the references are not compatible; Lynch teaches away from Gonsalves because the fat content of Gonsalves is excluded by Lynch. June 22 Amendment at pages 27-29. Because of these contrary teachings and because of other differences between the Lynch and Gonsalves compositions, it was argued that no person of skill in the art would combine these very different patents to arrive at Applicants' claimed compositions. June 22 Amendment at page 28.

As indicated in paragraphs 4 and 7 of the September 22, 2006 Office Action, Applicants' arguments were not deemed persuasive.

In response, Applicants submit experimental data demonstrating that the 7% maximum theoretical fat content of Lynch is critical. The data demonstrate that Lynch's fat content cannot be increased above the 7% limit and into the about 13 to 16% range as claimed by Applicants because to do so renders Lynch unsatisfactory for its intended purpose. Please see the Declaration of Thomas A. Konar submitted herewith pursuant to 37 C.F.R. § 1.132. The data demonstrate that the fat content limit of Lynch is a number that cannot be arbitrarily increased.

The data provided in the Konar declaration demonstrate that refrigerated samples of the Lynch composition congeal and thicken at fat contents of 13% and 16%. At least two negative consequences follow from this congealing and thickening: (1) Lynch cannot be dispensed properly from a pressurized container; and (2) Lynch's required overrun is essentially destroyed.

Regarding improper dispensing of the thickened Lynch composition from the containers, the data show that the Lynch compositions at 13% and 16% fat content did not flow easily from the pressurized containers. Konar declaration at paragraph 11. These Lynch compositions seemed to be stuck in the containers and dispensed slowly and irregularly, in a sputtering and spitting manner. *Id.* The Lynch composition material that did sputter out of the containers did not form well-defined rosettes; instead yielding deformed, jagged masses. *Id.* at paragraphs 11

and 12 and photograph Exhibit 1.

In contrast, compositions made according to the Buhler compositions at fat contents of 13% and 16% flowed quickly and easily from the containers to form well-defined rosettes with sharp, defined edges as can be seen in the side-by-side comparison of the Lynch and Buhler compositions in the photograph Konar declaration Exhibit 1. The rosettes formed from the Buhler compositions are attractive and would be useful for food preparation. *Id.* at paragraphs 11 and 12 and photograph Exhibit 1. The same cannot be said of the Lynch compositions as is apparent from the photograph.

Regarding destruction of Lynch's required overrun, the data show a precipitous decrease in overrun as the fat content of Lynch is increased from 7%, to 13% and to 16% fat content. Lynch claims a composition with overrun in excess of 300% and repeatedly discusses overruns of 300 and 500%. See Lynch at claims 1, 23 and col. 1, lines 11 and 40-43. Data provided at paragraphs 13-14 of the Konar declaration demonstrate that Lynch's overrun is 250% at 7% fat, 110% at 13% fat and only 50% at 16% fat. The bar graph provided as Konar Exhibit 2 powerfully demonstrates that increasing Lynch's fat content adversely effects Lynch's required overrun.

Mr. Konar describes the appearance of the 13% fat Lynch composition as being similar to that of a soft warm frosting while the 16% fat Lynch composition was stiff, similar to a frosting that is cold. *Id.* at paragraph 14. Konar Exhibit 3 is photograph showing samples of the 13% and 16% fat Lynch compositions. Note the defined edges of the thickened Lynch compositions providing a stiff appearance, quite unlike the appearance of a light, airy mass. A frosting-like appearance is unlike the whipped desert topping desired by Lynch at column 1, line 52 of the Lynch patent.

In summary, the evidence submitted herewith establishes that changing the fat content of Lynch to an amount above Lynch's 7 % maximum fat content and to an amount within Applicants' claimed range has important and adverse consequences. Increasing the fat content causes Lynch to thicken and congeal in an unacceptable manner resulting in at least loss of flow

from a pressurized container and destruction of overrun.

Independent claims 45, 49, 17, 26 and 28 are all amended to define Applicants' compositions as refrigerated products which are dispensed from a pressurized container. Lynch does not discuss or contemplate dispensing from a pressurized container and the data show that Lynch does not dispense properly from a pressurized container at fat contents within the range claimed by Applicants. The aforementioned claims further define Applicants' composition as having a fat content of about 13 to 16% by weight, a range which has been shown through evidence of record to be incompatible with Lynch, taken alone or in combination with Gonsalves.

Since Lynch requires a fat content outside of Applicant's range and increasing the fat content of Lynch adversely effects Lynch, the only fair conclusion is that Lynch teaches away from Applicants' composition as claimed. And, it must further be concluded that Lynch teaches away from Gonsalves to the extent that Gonsalves is combined with Lynch to supply the fat content range excluded from Lynch and claimed by Applicants. Therefore, there would be no motivation or suggestion to have modified the applied references because doing so, as posited in the ground of rejection, would render Lynch unsatisfactory for its intended purpose. *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984); MPEP § 2143.01(V).

In a manner of speaking, Lynch is the "lynch pin" of all the rejections based on § 103(a). If Lynch cannot be fairly applied, then all rejections must be withdrawn because Gonsalves and the other secondary references are unlike Applicants' invention and do not provide a separate basis for rejecting Applicants' claims for at least the reasons discussed in the June 22 Amendment at pages 27-31. For all of the foregoing reasons, it is respectfully requested that all claim rejections be withdrawn and that the claims be allowed.

In re Patent Application of:
Allen C. Buhler et al.
Serial No. 10/646,609

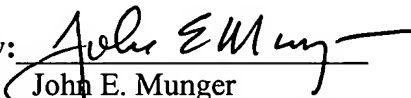
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Request for Interview

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly **requested to call** the undersigned at the telephone number listed below.

Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case. The Commissioner is authorized to debit deposit account 10-0270 to pay for the RCE and any other amounts due in connection with this paper except the issue fee. Kindly notify the undersigned in the event that the deposit account is debited or credited.

Respectfully submitted,

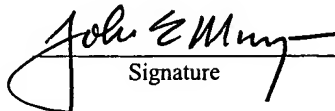
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: MAIL STOP RCE, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 on December 22, 2006.

John E. Munger
Name

 DECEMBER 22, 2006
Signature Date